

### **REMARKS/DISCUSSION OF ISSUES**

By this Amendment, Applicants: amend the specification; cancel claim 1 without prejudice against future prosecution or disclaimer of the underlying subject matter; amend claims 2-9, and add new claims 10-16. Accordingly, claims 2-16 are pending in the application.

Applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority documents, and that the drawings are acceptable.

Reexamination and reconsideration are respectfully requested in view of the following Remarks.

### **OBJECTION TO SPECIFICATION**

The Office Action objects to the specification in two places.

Applicants hereby amend the specification to address the first objection.

Applicants respectfully traverse the second objection. Applicants respectfully submit that the word "mobilities" is correct.

Accordingly, Applicants respectfully request that the objections to the specification be withdrawn.

### **CLAIM OBJECTIONS**

The Office Action objects to claim 9.

Applicants hereby amend claim 9 to delete the second appearance of the word "a."

Accordingly, Applicants respectfully request that the objection to claim 9 be withdrawn.

### **35 U.S.C. § 103**

At the outset it is noted that claims 4 and 7 have been rewritten to be in independent form, and claims 2-3, 5-6 and 8 have been amended to depend from claim 4.

The Office Action rejects claims 4-9 under 35 U.S.C. § 103 over Newsome et al. U.S. Patent Publication 2004/0115344 ("Newsome") in view of Becker et al. U.S. Patent 6,294,063 ("Becker") and Kawase U.S. Patent Publication 2004/0029382 ("Kawase").

Applicants respectfully traverse these rejections for at least the following reasons.

Claim 4

Among other things, in the system of claim 4 a small object is pre-treated by a monolayer to make a side of the object in contact with the substrate hydrophilic.

Applicants respectfully submit that no possible combination of the cited references would ever produce a system including this feature.

The Office Action fairly admits that neither Newsome nor Becker teach this feature.

Apparently, the Office Action relies on Kawase to teach this feature.

Applicants respectfully submit that Kawase neither teaches this feature nor even remotely suggests it. Kawase merely discloses a method of treating a hydrophobic substrate with a hydrophilic material to form patterns of varying wetting regions on a substrate for confining a second material to be subsequently deposited on the substrate into the desired pattern regions. Kawase does not teach any objects carried in a droplet. Kawase certainly does not suggest any objects carried in a droplet should be pre-treated by any monolayer. And even more specifically, Kawase does not disclose or suggest making a side of an object carried in a droplet that is to be in contact with a substrate hydrophilic.

So, no combination of Newsome, Becker, and Kawase would ever produce a system where a small object is pre-treated by a monolayer to make a side of the object in contact with the substrate hydrophilic.

Furthermore, Applicants also traverse the proposed combination of references as lacking any reason based in knowledge available in the prior art. M.P.E.P. § 2141(III) provides that:

*“[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”* KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

M.P.E.P. § 2144 further provides that:

*The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.*

Here, the Office Action fails to provide any evidence that any basis for the proposed rationale exists either as an express or implied statement in the prior art, or in knowledge generally available to one of ordinary skill the art.<sup>1</sup> Indeed, the proposed rationale does not appear to be based in anything except a hindsight reconstruction of Applicants' claim from Applicants' own teachings, which is an impermissible basis for combination.

Accordingly, for at least these reasons, Applicants respectfully submit that claim 4 is patentable over the cited art.

Claims 5-6 and 8

Claims 5-6 and 8 all depend from claim 4 and are deemed patentable over the cited art for at least the reasons set forth above with respect to claim 4.

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<sup>1</sup> To the extent that the Examiner is relying on personal knowledge as the basis for combining the references as proposed in the Office Action, Applicants respectfully request that the Examiner provide an affidavit in accordance with 37 CFR 1.104(d)(2).

Also, with respect to claim 5, Applicants submit that the cited references alone or in combination do not teach or remotely suggest the feature of pre-treating the small object to provide a dissolvable layer on a surface thereof.

The proposed rationale for the modification of Newsome not only lacks any rationale in the prior art, but frankly appears to make no sense! The Office Action completely fails to explain why it is believed that pre-treating the small object to provide a **dissolvable** layer on a surface thereof would somehow provide “*improved wettability of the substrate and alignment of the blocks onto the depressions (42) of the substrate (30).*” Where did the idea come from that a dissolvable layer on the object would do any of those things???

Accordingly, for at least these additional reasons, Applicants respectfully submit that claim 5 is patentable over the cited art.

Claim 7

Among other things, in the system of claim 7, the object is aligned with respect to the placement position by means of a magnetic field.

The Office Action fairly admits that the cited references do not disclose this feature. However, the Office Action asserts – without any support or evidence - that this is “*an obvious matter of design choice*” and further states that “Applicants have not disclosed that this feature “*solves any stated problem or is for any particular purpose.*”

Applicants respectfully traverse these statements.

At the outset, Applicants feel it is important to note that there is absolutely **NO** requirement for patentability that a claimed system perform in any way better to a system in the prior art. The only requirements are utility, novelty, and non-obviousness. Indeed, although not the case here, in fact a system that represents a giant step backward in the art is absolutely patentable so long as it is useful, novel, and non-obvious.

Here, the Office Action fails to provide any rationale or evidence supporting the conclusory statement that it is “*an obvious matter of design choice.*” Why is this a “design choice?” Where has anyone in the prior art ever employed such a “design choice” before? Thus, the Office Action fails to meet the requirements of M.P.E.P. §§ 2141(III) & 2144 as set forth above.

Furthermore, the specification absolutely does disclose that this feature is for a particular purpose, namely for orienting and indeed “flipping” the object (see page 5, lines 15-16).

Accordingly, for at least these reasons, Applicants respectfully submit that claim 7 is very clearly patentable over the cited art.

#### Claim 9

Among other things, the method of claim 9 includes orienting the object with respect to the placement position by means of a magnetic field.

As explained above with respect to claim 7, Applicants respectfully submit that the prior art fails to disclose or suggest orienting the object with respect to the placement position by means of a magnetic field.

Accordingly, for at least these reasons, Applicants respectfully submit that claim 9 is patentable over the cited art.

### **NEW CLAIMS 10-16**

New claims 10-16 all depend variously from claims 4, 8 and 9 and are deemed patentable for at least the reasons set forth above with respect to claims 4, 8 and 9, and because of various features recited therein.

### **CONCLUSION**

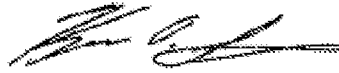
In view of the foregoing explanations, Applicants respectfully request that the Examiner reconsider and reexamine the present application, allow claims 2-16 and pass the application to issue.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843)

at (571) 283.0720 to discuss these matters.

Respectfully submitted,

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